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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/820,558	04/08/2004	Bennett Clay Byrd	41872-298797	8380
7590 03/03/2006				
J. Michael Boggs Kilpatrick Stockton LLP 1001 West Fourth Street Winston-Salem, NC 27101-2400			EXAMINER PATTERSON, MARIE D	
			ART UNIT 3728	PAPER NUMBER

DATE MAILED: 03/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/820,558

Applicant(s)

BYRD ET AL.

Examiner

Marie Patterson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 20-22 is/are allowed.
- 6) ☒ Claim(s) 1-19 and 23-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 4/8/04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

***Claim Rejections - 35 USC § 112***

1. Claims 10, 13, 25, and 30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 10, 25, and 30, the phrase "same as the combined thicknesses of the insole cut-out..." contradicts the limitation of substantially the same thickness of the midsole cut-out which is present in the independent claims from which these depend rendering the claims vague and indefinite.

Claim 13 is confusing, vague, and indefinite because it appears to merely recite and intended use and does not provide any additional structural limitations.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-3, 6, 11-13 15, 16, 18, 19, 23, and 26-28 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Serna (5983529).

Serna shows a shoe and inherent method of making a shoe comprising a midsole (10) with a cut-out (18), a display element (20), an outsole (30) , and a transparent portion (38) as claimed.

In reference to claims 12 and 23, the display element inherently has a color.

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4. Claims 1-4, 6-13, 15, 16, 18, 19, and 23-30 are rejected under 35 U.S.C. 102(b) as being anticipated by Frachey (5369896).

Frachey shows a shoe and inherent method of making a shoe comprising a midsole (3) with a cut-out (16), a display element (13 and/or 13A), and insole (5) with a cut-out (14), an outsole (2) , and a transparent portion (28) as claimed.

In reference to claims 12 and 23, the display element inherently has a color.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 4, 5, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over either Serna or Frachey.

Serna or Frachey shows a shoe substantially as claimed except for the exact shape of the insert. The use of oval as a shape is considered to be an obvious choice of design and official notice is taken that the use of the shape of circular or oval for heel cushions is well known and conventional in the art of footwear. It would have been obvious to make the heel inserts circular or oval as is well known and conventional in the footwear of either Serna or Frachey to make the footwear easier, faster, and cheaper to manufacture.

In reference to claim 17, the use of gel pads for heel cushions is extremely well known and conventional in the art of footwear and it would have been obvious to

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replace the heel cushion inserts of either Serna or Frachey with a gel filled insert to provide the user with a specific desired cushioning.

7. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Serna or Frachey in view of Weiss (2003/0084595).

Serna or Frachey shows a shoe substantially as claimed except for providing logo indicia on the insert. Weiss teaches providing logo indicia (14) on the bottom viewable portion of an insert. It would have been obvious to provide logo indicia as taught by Weiss in the shoe of either Serna or Frachey to provide viewable indicia for amusement, sales, etc..

***Allowable Subject Matter***

8. Claims 20-22 are allowed.

1. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). Other useful information can be obtained at the PTO Home Page at [www.uspto.gov](http://www.uspto.gov).

In order to avoid potential delays, Technology Center 3700 is encouraging FAXing of responses to Office Actions directly into the Center at (572)272-8300 **(FORMAL FAXES ONLY)**. Please identify Examiner Marie Patterson of Art Unit 3728 at the top of your cover sheet.

Any inquiry concerning the MERITS of this examination from the examiner should be directed to Marie Patterson whose telephone number is (571) 272-4559. The examiner can normally be reached from 6AM - 4PM Mon-Wed.



Marie Patterson  
Primary Examiner  
Art Unit 3728